SUPREME COURT, U. S.

FILED

NOV 30 1967

JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

No. 741

FRANK PETER DOYLE, JOHN HERBERT CHARLES NAYLER, GEORGE NEWBOLT ROLINSON,

Petitioners,

—v.—

EDWARD J. BRENNER, Commissioner of Patents,

Respondent.

MEMORANDUM FOR PETITIONERS IN OPPOSITION TO RESPONDENT'S OPPOSING MEMORANDUM

ALBERT L. JACOBS
Counsel for Petitioner
521 Fifth Avenue
New York, N. Y. 10017

Of Counsel:

ALBERT L. JACOBS, JR.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

No. 741

FRANK PETER DOYLE, JOHN HERBERT CHARLES NAYLER, GEORGE NEWBOLT ROLINSON,

Petitioners,

—v.—

EDWARD J. BRENNER, Commissioner of Patents,

Respondent.

MEMORANDUM FOR PETITIONERS IN OPPOSITION TO RESPONDENT'S OPPOSING MEMORANDUM

PREFATORY

The Honorable Solicitor General has inadvertently perpetuated or been led to perpetuate, in his Memorandum for the Commissioner of Patents in Opposition to Doyle *et al.'s* Petition, mistakes and errors both as to the chemistry and the law here involved. Thus, the Solicitor General's conclusion that the Writ of Certiorari should be denied is based on clear errors.

ERRORS OF CHEMISTRY

Phenoxyacetylpenicillanic acid is not known and may not even exist and in any event is definitely not 6-APA. Phenoxyacetylpenicillanic acid, therefore, cannot be a reagent in the production of any penicillin. "6-APA" is 6-aminopenicillanic acid which is an intermediate (the key nucleus) in the production of penicillin V and other penicillins. The Sheehan patent, the claims of which have been copied by Doyle *et al.* in seeking an Interference, do not relate to 6-APA itself, but relate only to the acylation of 6-APA (by the use of an RCO- containing compound) in order to synthesize penicillins therefrom, which penicillins have valuable antibiotic activity. 6-APA has no antibiotic activity. Sheehan did not invent 6-APA. 6-APA is protected by Doyle *et al.* United States Patent No. 3,164,604 which is commonly owned with application Serial No. 826,491 here involved by Beecham Group Limited. These most important facts have been lost sight of both by the Honorable Solicitor General and by the United States Court of Appeals for the District of Columbia Circuit, although the Court was fully advised with regard thereto.

This places the whole situation in a different context and perspective as must be appreciated and the serious errors in chemistry lie at the heart of and exemplify the misconstruction of the issues here involved.

ERRORS OF LAW

The Honorable Solicitor General in his Memorandum for Respondent relies heavily on *Brenner* v. *Manson,* 383 U. S. 519, 528, while failing to realize or recognize that anything contained in said decision, such as in footnote 12 relating to a potential Interference is purely *obiter dicta* because the *Brenner* v. *Manson* case was actually concerned with a very different point; namely, the question of the patentability of a process for producing compounds for which no utility was known or had been proved. This is the real thrust and basis of the *Brenner* v. *Manson* decision. It thus ineluctably follows that *Brenner* v. *Manson* was concerned with utility and proof of utility which is a matter of patent law involving Section 101 of Title 35 of the United States Code and perhaps Section 112, and therefore does not involve Section 135 of Title 35 of the United States Code which is here involved. Any comments by the Supreme Court of the United States to the contrary notwithstanding, the *Brenner* v. *Manson* case did not settle or even consider any of the issues here involved and presented now for this Court's consideration and Judgment in the Petition for Writ of Certiorari.

Insofar as footnote 12 of the *Brenner* v. *Manson* decision, *supra,* refers to the Application of Rogoff (commonly cited as *In re Rogoff,* 46 CCPA 733; 120 USPQ 185) both the Honorable Solicitor General and the United States Court of Appeals for the District of Columbia Circuit have not taken into account or given any weight to the vital fact that the *Rogoff* case involved a reissue question outside the reissue statute because Rogoff was attempting to patent by way of a reissue application claims neither broader nor

narrower than those of his granted patent and hence the Examiner properly rejected such claims. This is no precedent whatever for rejecting claims (found in another's patent as is the case here) on the very patent with which the Interference is sought. This in itself is a far reaching principle without precedent and not heretofore decided.

Factual and legal errors appear on page 2 and in footnote 3 of the Solicitor General's Memorandum for Respondent for the instant case does raise a question with respect to the quantum of proof necessary to institute an Interference because the Examiner has specifically conceded that while Petitioners have made a *prima facie* showing, they have not made a conclusive showing and which latter showing he maintains they must make. This the Solicitor General concedes (his memorandum—near bottom of page 2). This is not in accord with any Interference rule of the United States Patent Office and furthermore, if Doyle *et al.* had to and did present conclusive proof, there would be no point in declaring an Interference because they would have already in effect won the Interference and should not have to re-win it. In addition and because of the existence of Section 104 of Title 35 of the United States Code, Doyle *et al.*, being foreign inventors, are discriminatorily precluded from carrying their date of invention back of their underlying first British application (August 2, 1957) and which date has already been awarded to them. Certainly as a proper alternative, Doyle *et al.* have a right to attack the effective date of the Sheehan patent with which the Interference has been demanded and concededly plausible and reasonable affidavit evidence is already on record by outstanding and even world famous scientists such as Sir Robert Robinson, whose qualifications

and achievements are of record and are of the very highest calibre, including a Nobel Prize, as well as that of John Herbert Charles Nayler, one of the present Petitioners and who is an internationally recognized and outstanding authority in penicillin chemistry. The Patent Examiner, the Commissioner of Patents and the lower courts, have automatically accorded to Sheehan the benefit of his abandoned application filed March 1, 1957 as the effective date of his Patent No. 3,159,617 which issued on December 1, 1964 without permitting Doyle *et al.* any opportunity to contest the awarding of such date and in fact as is known to the Honorable Solicitor General, the Patent Office suspended action on Doyle *et al.'s* case and then without notice or warning of any sort to Doyle *et al.* issued the Sheehan patent and then Finally Rejected on the first action Doyle *et al.'s* application with respect to the Sheehan claims which Doyle *et al.* had on file long before the issuance of the Sheehan patent. This shows the inimical and inequitable attitude of the Patent Office toward Doyle *et al.'s* application, all based upon the fallacious proposition that Sheehan had invented 6-APA when, in fact, he did not and the records unquestionably prove this (see Patent No. 3,164,604 referred to, *supra*). Furthermore, even the penicillin V allegedly produced by Sheehan according to his abandoned March 1, 1957 application (see page 10 thereof) was specified as a racemate and was only obtained in a yield of 10% at most (Sheehan's own affidavit of May 1959) and based thereupon, penicillin never would have become commercially successful as it was Doyle *et al.*, not Sheehan, who made penicillins commercial and available to the public as "wonder drugs". In his abandoned application of March 1, 1957, Sheehan refers to the fact that

the L-isomer was inactive without in any way showing that he made or attempted the difficult optical resolution to obtain the D-isomer which is the only active isomer, it being common knowledge that racemates are made up of approximately 50/50 mixtures of D- and L-isomers and that in almost every instance of a racemate, only one isomer has any chemotherapeutic or biological value and activity and hence the inactive isomer is nothing but ballast or impurity. But even so, a 10% yield of racemate was nothing more than a laboratory curiosity contributing nothing of value or interest to the public or to the treatment of diseases caused by Gram negative and/or Gram positive micro-organisms and hence were matters left as Sheehan had left them, there would have been no contribution to the public and to the treatment of disease since Sheehan at most accomplished an ingenious total synthesis of racemic penicillin V, a matter of great scientific interest as a chemical exercise, but not of any practical or real utility or value otherwise.

Moreover, it will appear from what has preceded that in actuality, Petitioners should be set up as the senior party in the requested Interference and then Sheehan would have to show that he was entitled to his alleged March 1, 1957 date which concededly precedes Doyle *et al.'s* date of August 2, 1957 because of the restrictive nature of 35 USC 104, *supra.* It must also be borne in mind that while 35 USC 135 refers to conception of an invention, such alone is not enough to establish that an invention has been made since questions of reduction to practice, diligence, adequacy of notebook records, testimony of Sheehan, presence or lack of corroboration and many other factors enter into the correct determination of the outcome of an

Interference which is a proceeding set up by the Patent Office to determine which of various claimants is entitled to a patent since under existing United States patent law it is a fundamental principle that only the first inventor is entitled to a patent. Thus, mere conception is not enough and even assuming without admitting that Sheehan had the concept, it is necessary for him to show that he had and made the invention and that he had a prior basis for the claims involved in Doyle *et al.'s* demand for Interference. Petitioners have in fact complied with all the prescribed rules of the Commissioner of Patents, even the newest Interference rules effective July 1, 1965 which have never heretofore been interpreted and hence Petitioners maintain they had every right in asking the Commissioner of Patents to interpret his own newly promulgated rules, a request which the Commissioner refused to act upon even though a properly framed Petition (pursuant to his own rules) was filed asking him to do exactly that. There is thus a very broad underlying principle involved here which the Supreme Court of the United States should consider and pass upon; namely, whether the Commissioner of Patents or the head of any other administrative agency of the United States government can act arbitrarily or refuse to act or otherwise deprive Petitioners of due process of law and the right to obtain the needed and relevant testimony (from Sheehan and from his records) and insulate that action from judicial review. If the Commissioner of Patents can prevent his final action from being judicially reviewed, then likewise the Commissioners or administrative heads of other governmental administrative agencies can and will do the same to the detriment and damage of the rights of those thereby adversely affected. Contrary to the position of the Patent Office and appellate tribunals

so far involved, the issues raised by Petitioners are markedly different from and cannot be decided by the Patent Office Board of Appeals. The scope and interpretation of 5 USC 1009 and 28 USC 1361 are at issue here as well as the Patent Office Interference Rules.

Petitioners are clearly entitled to the review which they seek and they have no other effective remedy. There is no precedent directly in point contrary to Petitioners' position. *Brenner* v. *Manson* and *In re Rogoff*, both cited *supra*, are neither controlling nor dispositive of the issues raised by Doyle *et al.* These issues are exceedingly important and have wide ramifications. They can only be settled by the authority of the Supreme Court of the United States whose decision will bear importantly on public interests of inventors and others.

Respectfully submitted,

ALBERT L. JACOBS
Counsel for Petitioners

November 29, 1967